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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,463	08/02/2001	John Isaac Chandan Gomes	70006557-2	7205

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EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/922,463

Applicant(s)

GOMES ET AL.

Examiner

Mohammad A Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/29/04, 624/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-20 are presented for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al. (EP 0987868) (hereinafter Schwartz).
4. As per claim 1, Schwartz discloses a method for supplying at least one network path bookmark information to a mobile device, the network path bookmark information being stored in a client computer (106-1, 102, 114, fig 1, col 15, lines 14-51), wherein
  - a) the client computer determines the network path bookmark information (316, fig 3A, col 13, lines 25-50),

b) the client computer transmits the network path bookmark (col 15, lines 40-45) information to a server computer via a first communication network (LANDNET, 100, fig 1, col 16, lines 22-26),

c) the mobile device, which is connected to the server computer via a second communication network, requests the at least one network path bookmark information (106-1, 102, 114, fig 1, col 15, lines 14-51), and

d) the server computer transmits the requested network path bookmark information to the mobile device (URL, col 3, lines 7-26).

5. As per claim 2, Schwartz discloses the client computer extracts the network path bookmark information from a browser application being installed in the client computer (942, fig 9C, col 23, lines 14-26).

6. As per claim 4, Schwartz discloses the browser application is a internet browser application programme (Netscape, col 6, lines 6-25).

7. As per claim 5, Schwartz discloses mobile device transmits a request for the network path bookmark information to the server computer, and wherein the server computer sends a request for the requested network path bookmark information to the client computer (col 3, lines 7-26).

8. As per claim 6, Schwartz discloses wherein the mobile device transmits a request for a network path bookmark information to the server computer (col 3, lines 7-26),

wherein the server computer determines whether the requested network path bookmark information is already stored in the server computer, wherein, in case that the requested network path bookmark information is not stored in the server computer, the server computer transmits a request for the network path bookmark information to the client computer, and the client computer transmits the requested network path bookmark information to the server computer (col 15, lines 14-51), and

wherein, in case that the network path bookmark information is stored in the server computer (address table, col 24, lines 31-44), the server computer transmits the requested network path bookmark information to the mobile device (col 15, lines 14-51).

9. As per claim 7, Schwartz discloses the network path bookmark information is encoded according to the HTML format or according to the WML format (col 10, lines 44-55).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3, 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al. (EP 0987868) (hereinafter Schwartz) in view of Flynn M Et al. ("The satchel system architecture: mobile access to document services", ACM, Vol 5, December 2000,) (hereinafter Flynn).

12. As per claim 9, As per claim 9, Schwartz discloses a method for supplying remotely stored information to an appliance via a mobile device, the appliance being connected to a first computer system, the method comprising the following steps:

determining at least one network path bookmark information designating a remotely stored information to be processed, wherein the determination of the network path bookmark information comprises (106-1, 102, 114, fig 1, col 15, lines 14-51) the following steps:

a) the client computer determines the network path bookmark information (316, fig 3A, col 13, lines 25-50),

b) the client computer transmits the network path bookmark (col 15, lines 40-45) information to a server computer via a first communication network (LANDNET, 100, fig 1, col 16, lines 22-26),

c) the mobile device, which is connected to the server computer via a second communication network, requests the at least one network path bookmark information (106-1, 102, 114, fig 1, col 15, lines 14-51), and

d) the server computer transmits the requested network path bookmark information to the mobile device (URL, col 3, lines 7-26).

Schwartz does not explicitly disclose designating the determined network path bookmark information of the remotely stored information to be processed and the appliance to which the information, which is connected to the network path bookmark information, is to be applied as instructions in the mobile device, transmitting the instructions from the mobile device to the first computer system via a first communication network, retrieving the information and converting the information to a format suitable for the appliance, and supplying the information to the appliance for processing according to the instructions. However, Flynn discloses designating the determined network path bookmark information of the remotely stored information to be processed and the appliance to which the information,

which is connected to the network path bookmark information, is to be applied as instructions in the mobile device (pages 244-245, section 3, Architectural overview),

transmitting the instructions from the mobile device to the first computer system via a first communication network (fig 1, pages 244-245, section 3, Architectural overview),

retrieving the information and converting the information to a format suitable for the appliance (printer, scanner, HTML, pages 244-245, section 3, Architectural overview), and

supplying the information to the appliance for processing according to the instructions (printer, scanner, HTML, pages 244-245, section 3, Architectural overview). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Schwartz and Flynn. The motivation would have been providing access to documents and services to mobile devices.

13. As per claims 3 and 10, claims are rejected for the same reasons as claim 9, above. In addition Flynn discloses the client computer extracts the network bookmark information from a predetermined directory of the client computer, in which the browser application stores its network path bookmark information (printer, scanner, pages 244-245, section 3,



Architectural overview).

14. As per claim 8, the claim is rejected for the same reasons as claim 9, above. In addition Flynn discloses client computer determines the network path bookmark information from a predetermined directory in the client computer (pages 244-245, section 3, Architectural overview).

15. As per claim 11, the claim is rejected for the same reasons as claim 4, above.

16. As per claim 12, the claim is rejected for the same reasons as claim 9, above. In addition, Flynn discloses the instructions are transmitted from the mobile device to an appliance server computer, wherein the appliance server computer retrieves the information using the network path bookmark information and converts the information to a format suitable for the appliance, and wherein the appliance server computer applies the information to the appliance for processing according to the instructions (printer, scanner, web Server, fig 1, pages 244-245, section 3, Architectural overview).

17. As per claim 13, the claim is rejected for the same reasons as claim 9, above. In addition Flynn discloses a plurality of appliances are connected to the first computer system, the mobile device further designating the appliance among said plurality of appliances in the instructions (printer, scanner, web Server, fig 1, pages 244-245, section 3, Architectural overview).

18. As per claim 14, the claim is rejected for the same reasons as claim 9, above. In addition Flynn discloses plurality of appliances are registered in the first computer system (printer, scanner, web Server, fig 1, pages 244-245, section 3, Architectural overview).

19. As per claim 15, the claim is rejected for the same reasons as claim 9, above. In addition Flynn discloses the mobile device designates the appliance by specifying the client's identity in the instructions (printer, scanner, web Server, fig 1, pages 244-247).

20. As per claim 16, the claim is rejected for the same reasons as claim 9, above. In addition Flynn discloses the first network includes a gateway with which the mobile device communicates by using standard telecommunication protocols, and the gateway converts the instructions to a format which the

first computer system understands (gateway, fig 1, pages 244-245).

21. As per claim 17, the claim is rejected for the same reasons as claim 9, above. In addition Flynn discloses the information is stored in a second computer from which the first computer system retrieves the information according to the instructions (pages 244-247).

22. As per claim 18, the claim is rejected for the same reasons as claim 9, above. In addition Flynn discloses wherein the appliance is a printer, and the first computer system converts the information to a print job in a format suitable for printing (page 249, The Print Service).

23. As per claim 19, the claim is rejected for the same reasons as claim 9, above. In addition Flynn discloses the first computer system converts the information to a PDL format for printing page 249, The Print Service).

24. As per claim 20 the claim is rejected fro the same reasons as claim 9, above.

***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent 6,285,889

U.S. Patent 6,256,666

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAS

 **JOHN FOLLANSBEE**  
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